

REMARKS

This communication responds to the *Office Action* dated January 6, 2011. Applicants have amended claims 1, 19-37, and 55. Claims 73-112 were previously canceled. No claims are presently canceled and no claims are added. Consequently, claims 1-72 remain pending in this application.

Examiner's Interview

Applicants sincerely thank Examiner Rutkowski for the courtesy of an Interview on April 5, 2011. During the Interview, the undersigned attorney and the Examiner discussed the reference of U.S. Patent No. 6,112,246 to Horbal *et al.* (*Horbal*). Applicants reminded the Examiner that the Applicants' prior amendment of each of Applicants' independent claims included the limitation "without requiring a proxy device and without requiring a server to enable communications." This limitation was added to more clearly differentiate from *Horbal* since *Horbal* **requires** a micro-server embedded in each communications device. Consequently, Applicants submitted that a skilled artisan would not consider looking to *Horbal* to teach or suggest Applicants' claims since *Horbal* requires the micro-server in each device. Since Applicants' claims specifically disclaim incorporating a server or proxy into the communications devices, *Horbal* teaches away from the problem solved by Applicants' claimed invention. The Examiner suggested adding the limitation of "without requiring a proxy device and without requiring a server to enable communications" at the beginning of each independent claim in order to make clear that the limitation is applicable to each claimed element. The Examiner suggested that these amendments would likely overcome the rejection of Applicants' claims under 35 U.S.C. § 103(a). Applicants thank the Examiner for his suggestion and have accordingly incorporated the amendment into each independent claim.

The Rejection of Claims Under 35 U.S.C. § 101

On page 2, paragraph 3 of the *Office Action*, the Examiner rejected claims 19-35 under 35 U.S.C. § 101 because the claims are allegedly directed to non-statutory subject matter. Specifically, the Examiner stated that,

Neither the claims nor the specification limits the scope of the 'machine-readable storage medium' to a non-transitory medium because the specification defines the 'machine-readable storage medium' in an open-ended manner (see page 25 lines 15-24). Therefore, Examiner asserts that the claimed 'machine-readable storage medium' can be transitory signal. Transitory signal is a signal per se, which falls into a non-statutory subject matter.¹

Although Applicants are perplexed how a "machine-readable storage medium" can be considered transitory, since a "storage medium" is a tangible object, Applicants have nonetheless amended claims 19-36² to recite, *inter alia*, a "non-transitory machine readable storage medium." According to recent instructions issued by the USPTO, "A claim drawn to such a computer readable medium . . . may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation 'non-transitory' to the claim."³ The USPTO has instructed that, "Such an amendment would typically not raise the issue of new matter."⁴ Applicants therefore respectfully request the Examiner to reconsider and remove the rejection of claim 19 under 35 U.S.C. §101. Further, since claims 20-36 depend from claim 19, they too are patent eligible for at least the same reasons as the claim from which they depend.

The Rejection of Claims Under 35 U.S.C. § 103(a)

On page 3, paragraph 6 of the *Office Action*, the Examiner rejected claims 1-8, 11-26, 29-44, 47-62, and 65-72 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,112,246 to Horbal *et al.* (*Horbal*), in view of U.S. Published Patent Application No. 2002/0143855 to Traversat *et al.* (*Traversat*), and U.S. Patent No. 4,748,618 to Brown *et al.* (*Brown*). Applicants respectfully traverse the rejection.

The basis for an obviousness rejection is grounded in a consideration of all claim elements. "All words in a claim must be considered in judging the patentability of that claim

¹ *Office Action* at 2.

² Although claim 36 was not rejected under this section, claim 36 has also been amended since it also depends from claim 19.

³ USPTO Notice, "Subject Matter Eligibility of Computer Readable Media," issued January 26, 2010.

⁴ *Ibid*.

against the prior art.”⁵ Additionally, to render the claimed subject matter obvious, the prior art references must teach or suggest every feature of the claims.⁶

Applicants’ amended independent claim 1 recites, *inter alia*,

[W]ithout requiring a proxy device and without requiring a server to enable communications,

initiating a discovery request from a communication device over a network;

receiving one or more responses from the discovery request from dissimilar communication devices on the network . . . ; and

transmitting data between the communication device and the dissimilar communication devices.⁷

Each of Applicants’ other independent claims, namely claims 19, 37, and 55, share with claim 1 limitations similar to at least those recited immediately above.

Although Applicants do not admit that *Brown* or *Traversat* teach or suggest any element of Applicants’ claims, Applicants will instead focus on what is neither taught nor suggested by *Horbal* in any combination with *Brown* or *Traversat*.

In contrast to Applicants’ claimed elements and as discussed in the Interview, *Horbal* discusses installing a server into each device to enable communications.

A micro-server adapted to be embedded into a piece of industrial machinery, an automobile, *a consumer product*, and the like . . . The micro-server is capable of interfacing with a device to access information from the device, such as control or maintenance information. *The micro-server can then organize and format that information compatible with a communication protocol.*⁸

⁵ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03.

⁶ See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaack*, 947 F.2d, 488 (Fed. Cir. 1991). Cited approvingly in *Ex parte WEN WEN* and *PATRICIA NG* at 7; Appeal No. 2009-000776; decided September 25, 2009.

⁷ Emphasis added.

⁸ *Horbal* at Abstract; emphasis added.

Thus, in contrast to at least Applicants' claimed element of "without requiring a proxy device and without requiring a server to enable communications," *Horbal* **requires** embedding a server into each of the dissimilar communication devices. Consequently, Applicants submit that *Horbal* teaches away from Applicants' claimed invention.

The Federal Circuit has maintained that "a person of ordinary skill, upon examining the reference, would be discouraged from following the path set out in the reference, or would be led in a direction different from the path that was taken by the applicant."⁹ References that teach away from a claim cannot be used to establish obviousness of the claim with respect to that element.¹⁰ In these and other cases, the Federal Circuit has consistently held that a reference can teach away when a person of ordinary skill, upon reading the reference, would merely be "discouraged" from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

Further, MPEP § 2144.05(III) states that, "A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention." Accordingly, where cited art teaches away from a claimed feature, the cited art is not available for the purposes of an obviousness rejection. In the instant case, *Horbal* not only fails to teach or suggest a method or apparatus for device communications without embedding a proxy or micro-server, but further teaches away from the use thereof. As discussed, above, *Horbal* requires embedding a server into each of the dissimilar communication devices. Therefore, *Horbal* explicitly teaches away from "without requiring a proxy device and without requiring a server to enable communications" as recited by each of Applicants' independent claims. Since *Horbal* teaches away from at least this claim limitation, one of ordinary skill in the art would not look to modify *Horbal* to incorporate certain features of *Trersat* or *Brown* in an effort to arrive at the claimed invention. Accordingly, Applicants respectfully submit that the rejection is improper and respectfully request that the rejection be withdrawn.

⁹ *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

¹⁰ *See Ecolchem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1375 (Fed. Cir. 2000).

Claims 9, 10, 27, 28, 45, 46, 63, and 64

On page 9, paragraph 29 of the *Office Action*, the Examiner rejected claims 9, 10, 27, 28, 45, 46, 63, and 64 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Horbal* in view of *Traversat* and *Brown*, as applied to claims 4, 22, 40, and 58 respectively above, and further in view of U.S. Published Patent Application No. 2002/0099867 to Wilkinson et al. (*Wilkinson*). However, each of these claims depend either directly or indirectly from one of the independent claims, 1, 19, 37, or 55, that Applicants have shown to be allowable. *Wilkinson* does nothing to cure the deficiencies not found in either *Horbal*, *Traversat*, or *Brown*. Thus, each of these dependent claims is allowable for at least the same reasons as given above with regard to the independent claims from which they depend. Further, each of these dependent claims may be allowable for its own limitations.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is sincerely invited to telephone the undersigned attorney at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(408) 660-2015

Date April 6, 2011

By


Bradley W. Scheer
Reg. No. 47,059